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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/074,364 | 02/12/2002 | Brian N. Tufte | 1076.1101104 | 9076 |
| 28075 | 7590 | 05/11/2004 | EXAMINER | |
| CROMPTON, SEAGER & TUFTE, LLC 1221 NICOLLET AVENUE SUITE 800 MINNEAPOLIS, MN 55403-2420 | | | NEGRON, ISMAEL | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2875 | |

DATE MAILED: 05/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-----------------|-----------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/074,364 | TUFTE, BRIAN N. | |
| | Examiner | Art Unit | |
| | Ismael Negron | 2875 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 19 December 2003.

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1,2,4-6 and 9-31 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☒ Claim(s) 1,2,4-6,9,10 and 24-30 is/are allowed.

6) ☒ Claim(s) 11-23 is/are rejected.

7) ☒ Claim(s) 31 is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on 04 June 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/18/03, 12/22/03.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed on December 19, 2003 has been entered. Claims 1, 4, 5 and 9-12 have been amended. Claims 3, 7 and 8 have been cancelled. Claims 23-31 have been added. Claims 1, 2, 4-6 and 9-31 are still pending in this application, with claims 1, 11, 12 and 29 being independent.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 12-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 is indefinite as it is not clear what the claimed "relatively uniform light output" is.

Claims 13-23 are rejected for their dependency on rejected claim 12.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 11-20 are rejected under 35 U.S.C. 102(b) as being anticipated by NAGANO (U.S. Pat. 5,430,627).

Nagano discloses an illumination device having:

- **an elongated light source**, Figure 9, reference number 61;
- **an elongated member**, Figure 7, reference number 111;
- **the elongated member having a cavity**, Figure 7, reference number 129;
- **the cavity being for receiving the elongated light source**, column 3, lines 56 and 57;
- **the cavity being at least partially defined by a first material that is at least partially transparent**, Figure 7, reference number 143;
- **the first material extending to the outer surface of the elongated member**, Figure 7;
- **the elongated member including a second material that is substantially non-transparent**, Figure 7;
- **a stair**, inherent;
- **the stair including a substantially horizontal surface terminating in a ledge**, inherent;
- **the stair also including a downwardly extending surface**, inherent;

- **the elongated member extending at least over part of the horizontal surface of the stair**, Figure 7, reference number 113;
- **the elongated member also extending at least over part of the downwardly extending surface of the stair**, Figure 7, reference number 115;
- **the cavity being positioned adjacent the ledge**, Figure 7, reference number 129;
- **the cavity being positioned adjacent the substantially horizontal surface**, Figure 7, reference number 129;
- **the first material extending over two or more surfaces of the elongated member**, Figure 7, reference numbers 143 and 145;
and
- **a portion of the second material separating the two or more surfaces having the first material**, Figure 7, reference number 131.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

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Patentability shall not be negated by the manner in which the invention was made.

4. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over NAGANO (U.S. Pat. 5,430,627).

NAGANO discloses an illumination device having:

- **an elongated light source**, Figure 9, reference number 61;
- **an elongated member**, Figure 7, reference number 111;
- **the elongated member having a cavity**, Figure 7, reference number 129;
- **the cavity being for receiving the elongated light source**, column 3, lines 56 and 57;
- **the cavity being at least partially defined by a first material that is at least partially transparent**, Figure 7, reference number 143;
- **the first material extending to the outer surface of the elongated member**, Figure 7.

Nagano discloses all the limitations of the claims, except the elongated light source being an electro luminescent wire (ELEW) or a linear emitting fiber (LEF).

The examiner takes Official Notice that the use of ELEW and LEF is old and well known in the illumination art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute an ELEW or LEF for the elongated light source in the system of Nagano. One would have been motivated since ELEW and LEF are recognized in the illumination art to have many desirable advantages, including

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reduced size, high efficiency, low power consumption, long life, resistance to vibrations, and low heat production, over other light sources.

Allowable Subject Matter

5. Claims 1, 2, 4-9, 9, 10 and 24-30 are allowed.
6. Claim 23 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
7. Claim 31 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
8. The following is a statement of reasons for the indication of allowable subject matter:

Applicant teaches an illumination device having an elongated member for receiving a light source, such member having an outer surface made of a first, at least partially transparent material, and a second, at least substantially non-transparent material. A cavity extends at least along a part of the length, such cavity being for receiving the light source. The cavity is formed in part by the first material and extends

to two or more portions of the outer surface of the elongated member. The two or more portions of the outer surface are separated from one another by a separating portion of the outer surface that includes the second material.

No prior art was found teaching individually, or suggesting in combination, all of the features of the applicants' invention, specifically an elongated member for receiving a light source, such member having cavity formed in part by the first material and extending to two or more portions of the outer surface of the elongated member, such portions being separated from one another by the second material.

Response to Arguments

9. Applicant's arguments with respect to claim 1, 23, 29 and 31 have been fully considered and are persuasive.
10. Applicant's arguments filed December 19, 2003 have been fully considered but they are not persuasive.
11. Regarding the Examiner's rejection of claim 11 under 35 U.S.C. 102(b) as anticipated by NAGANO (U.S. Pat. 5,430,627), the applicant argues that the cited reference fails to disclose all the features of the claimed invention, specifically the elongated member being *monolithic*.

The Merriam Webster's Collegiate Dictionary, 10 ed., defines **monolithic** as:

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mono·lith·ic: "mä-n&l-'i-thik adj. (1825)**1 a :** of, relating to, or resembling a monolith : **HUGE, MASSIVE****b (1) :** formed from a single crystal <a *monolithic* silicon chip>(2) : produced in or on a monolithic chip <a *monolithic* circuit>**2 a :** cast as a single piece <a *monolithic* concrete wall>**b :** formed or composed of material without joints or seams<a *monolithic* floor covering> <a *monolithic* furnace lining>**c :** consisting of or constituting a single unit**3 a :** constituting a massive undifferentiated and often rigid whole <a *monolithic* society>**b :** exhibiting or characterized by often rigidly fixed uniformity<*monolithic* party unity> - **mono·lith·i·cal·ly** /-thi-k(&-)IE/*adverb*

Definitions 1 and 3 are not relevant.

Definition 2b is also not relevant, as it does not describe the claimed elongated member having two dissimilar materials, which, inherently, includes joints and seams.

The only applicable definitions are 2a (cast as a single piece) and 2c (consisting or constituting a single unit).

Nagano discloses an illumination device having an elongated member with a cavity, such cavity being for receiving an elongated light source. The cavity is partially defined by a first transparent portion extending from the cavity to the outer surface of the elongated member. The elongated member also includes a second substantially non-transparent portion. The first and second portions are held together by mechanical means to form a single unit, meeting the *monolithic* requirements as stated by definition 2c.

In addition, the applicant is respectfully reminded that it has been held by the courts that the term "*integral*" is sufficiently broad to embrace construction means such as fastening and welding. *In re Hotte*, 177 USPQ 326, 328 (CCPA 1973).

12. Regarding the Examiner's rejection of claim 12 under 35 U.S.C. 102(b) as anticipated by NAGANO (U.S. Pat. 5,430,627), the applicant argues that the cited reference fails to disclose all the features of the claimed invention, specifically the elongated light source providing a relatively uniform output.

The use of the term "relatively" fails to positively define the claimed invention, as it is not clear what degree of uniformity is the applicant's light source providing.

The light source disclosed by NAGANO being formed of a large number of point-like sources (as evidenced in column 1, lines 26-29) disposed in close proximity of one another was considered to meet the "relatively uniform light output" limitation, specially in combination with a translucent cover or lens (reference numbers 43, 45, 143 and 245).

13. With respect to claims 13-22 the applicant presents no arguments, except stating that such claims are dependent upon claims 11 or 12, and would be allowable when/if claims 11 and 12 are allowed.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

15. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ismael Negron whose telephone number is (571) 272-2376. The examiner can normally be reached on Monday-Friday from 9:00 A.M. to 6:00 P.M.

16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea, can be reached at (571) 272-2378. The facsimile machine number for the Art Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications maybe obtained from either Private PAIR or Public PAIR. Status

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information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://pair-direct.uspto.gov>. Should you have questions on access to Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197.



**THOMAS M. SEMBER
PRIMARY EXAMINER**


Inr

May 5, 2004